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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,672	11/28/2001	Peter S. Weissman		8288

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EXAMINER

PATEL, DHAIRYA A

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/994,672	Applicant(s) WEISSMAN, PETER S.	
	Examiner Dhairya A Patel	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/20/2003</u> , <u>02/03</u> , <u>02/24/03</u> , <u>11/28/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Application # 09/994,672 was filed on 11/28/2001. Claims 1-20 are subject to examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1-9, the claim recites "The mail program of.." which is considered non-statutory subject matter because this may be interpreted as written software code on a piece of paper.

As per claim 12-13, the claim recites " An email " which is considered non-statutory subject matter because this may be interpreted as written software code on piece of paper.

As per claim 14-20, the claims recites "A software application having instructions that when executed by a processor cause the processor to execute the steps comprising the steps of: " is considered non-statutory subject matter because this may be interpreted as written software code on piece of paper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2151

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2,5-18,20 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaw et al. U.S. Patent # 6,247,045 (hereinafter Shaw)

2. As per claim 1, Shaw teaches a mail program comprising:

- a first email (Fig. 8A) having a first message (Fig. 8A element 800) with at least one primary recipient (Fig. 8A element "TO:"); and

- a second email (Fig. 8A) having a second message (Fig. 8A element 802) with at least one secondary recipient (Fig. 8A element "CC"), the second e-mail associated with the first email and processed simultaneously with the first email (Fig. 8A) (column 8 lines 64-67) (column 9 lines 1-9).

In this figure, there are two recipients. Primary recipients are addressed in "TO: Developers" and secondary recipients are addressed in "CC: Vance Worthingly, Mike Foster, etc.)

3. As per claim 2, Shaw teaches the mail program of claim 1, wherein each of the at

least one secondary recipient(s) are different than the at least one primary recipient(s).
(Fig. 8A element "TO" and "CC")

In this figure, there are two recipients. Primary recipients are addressed in "TO: Developers" and secondary recipients are addressed in "CC: Vance Worthingly, Mike Foster, etc.)

4. As per claim 5, Shaw teaches the mail program of claim 1, wherein the first message and the second message are created by a sender and simultaneously transmitted by mail program. (Fig. 8A) (column 8 lines 64-67) (column 9 lines 1-9).

In the figure 8A, the upper left hand corner it shows the first and second messages are created by a sender and simultaneously transmitted by mail program because it has the sender name "Julie Key" and the date "12/18/98" and time "4:35PM"

5. As per claim 6, Shaw teaches the mail program of claim 1, wherein the first message and the second message are simultaneously received by the mail program for one of the primary recipient (Fig. 8B message 810) and the secondary recipient (Fig. 8c element 812 and 806) (Column 9 lines 10-19)

In he figure 8B, it shows the primary recipient receiving the message, and in Fig. 8C, the secondary recipient receiving first message with the second message.

6. As per claim 7, Shaw teaches the mail program of claim 1, wherein the first email and the second email are transmitted to each of the at least one primary recipient and the at least one secondary recipient as a single electronic mail. (Fig. 8A) (column 8 lines 64-67) (column 9 lines 1-9).

In figure 8A, it shows both are transmitted in single electronic mail.

7. As per claim 8, Shaw teaches the mail program of claim 1, wherein at least one of the at least one secondary recipients receives the first message and the second message. (Fig. 8C element 812 and 806) (column 9 lines 10-19)

In figure 8C, it shows that Vance receives first message (Fig. 8C element 812) and the second message (Fig. 8C element 806).

8. As per claim 9, Shaw teaches the mail program of claim 1, wherein at least one of the at least one primary recipient receives the first message but not the secondary message. (Fig. 8B element 810) (column 9 lines 10-19)

In the figure 8B, it shows the primary recipients (Fig. 8B element "TO: Developers") received the primary message (Fig 8B element 810) but not the secondary message (Fig. 8A element 802)

9. As per claim 10, Shaw teaches the mail program of claim 1, wherein said mail program comprises a mail service (column 6 lines 38-56) (fig. 4).

10. As per claim 11, Shaw teaches the mail program of claim 1, wherein said mail program comprises a mail client (column 6 lines 38-56) (Fig. 3 & 4).

11. As per claim 12, Shaw teaches an email comprising:

- a primary window (Fig. 8A element "big solid line outside box") having a primary message (Fig. 8A element 800) with at least one primary recipient (Fig. 8A element "TO:"); and

- a secondary window (Fig. 8A element "dotted-line inner box") having a secondary message (Fig. 8A element 802) with at least one secondary recipient (Fig.

8A element "CC"), the secondary window separate from and associated with the primary window. (Fig. 8A)

In Fig. 8A it shows that boxes are separate and it is associated with the primary window (Fig. 8A element "dotted-line inner box")

12. As per claim 13, Shaw teaches the email of claim 12, wherein each of the at least one recipient(s) are different than the at least one primary recipient(s). (Fig. 8A element "TO" and "CC")

In this figure, there are two recipients. Primary recipients are addressed in "TO: Developers" and secondary recipients are addressed in "CC: Vance Worthingly, Mike Foster, etc.)

13. As per claim 14, Shaw teaches a software application having instructions that, when executed by a processor, cause the processor to execute the steps comprising the steps of (Fig. 2,3,4):

- processing a primary email (Fig. 8A) having at least one primary recipient (Fig. 8A element "TO:") and

- processing a secondary email (Fig. 8A) having at least one secondary recipient (Fig. 8A element "CC"), the secondary email associated with the primary email and processed simultaneously with the processing of the primary email (Fig. 8A) (column 8 lines 64-67) (column 9 lines 1-9).

In this figure, there are two recipients. Primary recipients are addressed in "TO: Developers" and secondary recipients are addressed in "CC: Vance Worthingly, Mike Foster, etc.)

14. As per claim 15, it teaches same limitations as claim 2 therefore rejected under same basis.

15. As per claim 16, Shaw teaches the software application of claim 14, wherein said processing the primary email comprises generating the primary email (Fig. 8A element 800) and said processing the secondary email comprises generating the secondary message email (Fig. 8A element 802).

16. As per claim 17, Shaw teaches the software application of claim 14, wherein said processing the primary email comprises receiving the primary email (Fig. 8A element 800, Fig. 8B element 810) and said processing the secondary email comprises generating the secondary message email (Fig. 8A element 802, Fig. 8C element 812, 806).

17. As per claim 18, Shaw teaches the email of claim 12, wherein the secondary window is sent but not displayed to, the primary recipient (Fig. 8B & Fig. 8A).

In figure 8a, it shows the secondary window is sent but in the Fig. 8B it shows the secondary window is not displayed.

18. As per claim 20, Shaw teaches the software application of claim 14, wherein said processing the primary email comprises transmitting the primary email (Fig. 8A element 800) to the at least one primary recipient (Fig. 8A element "TO; Developers), and said processing the secondary email comprises transmitting the secondary email (Fig. 8A element 802) to the at least one secondary recipient (Fig. 8A element "CC: Vance Worthingly") (column 8 lines 65-67) (column 9 lines 1-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. U.S. Patent 6,247,045 (hereinafter Shaw) in view of Thurlow et al. U.S. Patent # 6,456,879 (hereinafter Thurlow)

As per claim 19, Shaw teaches the email of claim 12, but fails to teach further comprising a primary tab associated with the primary window and a secondary tab associated with the secondary window, wherein the primary and secondary tabs enable the selective display of the primary window and secondary window. Thurlow teaches a primary tab associated with the primary window (Fig. 3 element "General") and a secondary tab associated with the secondary window (Fig. 3 element "Connection"), wherein the primary and secondary tabs (Fig. 3 element 301) enable the selective display of the primary window and secondary window. It would have obvious to one of ordinary skill in the art at the time of applicant's invention to implement Shaw's invention in Thurlow's invention to come up with a tab associated with primary and secondary window in order to view selective display of primary and secondary window. The motivation for doing so would have been to distinguish between primary and secondary window and in order to view those windows separately.

Claims 3,4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. U.S. Patent 6,247,045 (hereinafter Shaw).

19. As per claim 3, Shaw teaches the mail program of claim 1, but is silent on wherein the at least one secondary recipient(s) are the same as the at least one primary recipient(s). (Fig. 8A). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add at least one secondary recipient(s) ("CC:") name in the primary recipient section ("TO:"). The motivation for doing so would have to address the issue written in the e-mail to the one secondary recipient who was added to the primary recipient and to send a private e-mail to the secondary recipients.

As per claim 4, Shaw teaches the mail program of claim 1, further comprising a plurality of primary recipients, wherein the at least one secondary recipient is one of the plurality of primary recipients. (Fig. 8A). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add one of plurality of primary recipient(s) ("TO:") name in the secondary recipient section ("CC:"). The motivation for doing so would have to address the issue written in the e-mail to let the secondary recipients know about the issue being addressed to the plurality of primary recipient and to send a private e-mail to the secondary recipients.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A). "Method and Apparatus for sending private messages within a single electronic message" by Shaw et al. U.S. Patent # 6,247,045

A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A Patel whose telephone number is (571) 272-4066. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAP


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER